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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/800,708	03/16/2004	Hiroshi Gotoh	R2184.0306/P306	1766
24998	7590	12/12/2006	EXAMINER	
DICKSTEIN SHAPIRO LLP 1825 EYE STREET NW Washington, DC 20006-5403				SANDERS, AARON J
			ART UNIT	PAPER NUMBER
			2169	

DATE MAILED: 12/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/800,708	GOTOH, HIROSHI
	Examiner	Art Unit
	Aaron J. Sanders	2169

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 02 November 2006.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-3,5-8 and 10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-3,5-8 and 10 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) Notice of Informal Patent Application
- 6) Other: _____

DETAILED ACTION

Response to Amendment

This Office action has been issued in response to amendment filed 2 November 2006.

Claims 1-3, 5-8, and 10 are pending. Applicants' arguments have been carefully and respectfully considered in light of the instant amendment and are persuasive, except as they relate to the claim rejections under 35 USC 102, as will be discussed below. Accordingly, this action has been made FINAL.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Takano, U.S.

P.G. Pub. 2002/0082917.

As per claims 1-10, Takano teaches:

1. A method of reproducing information using an information recording medium in a client/server system, the method comprising the steps of:
(a) a client obtaining characteristic information of the information recording medium
(See Fig. 7 Step S701, 'read card management information' where, as shown in Fig. 1, the depicted 'kiosk returning terminal' is a client of a 'kiosk management server');

- (b) the client transmitting the characteristic information to a server (See e.g. Fig. 7 Step S702, 'transmit card management information and own terminal information to distribution center via kiosk management server');
- (c) the server obtaining usage information of the information recording medium based on the characteristic information (See e.g. Fig. 8A Step S801, 'receive card management information' and Step S803, 'obtain/calculate and prepare user name, program title, usage period, information of additional fee');
- (d) the server transmitting information based on the usage information to the client (See e.g. Fig. 7 Step S703, "receive information from distribution center via kiosk management server" and [0080-81], "In S805, a customized list is taken out, from preference ID data prepared based on the use history record of the user, from management data recording apparatus 408. In S806, the data thus prepared is transmitted through kiosk management server 170 to kiosk returning terminal 110. Returning to FIG. 7, kiosk returning terminal 110 that has received in S703 the information transmitted in S806 displays the data on display unit 203 in S704"); and
- (e) the client reproducing the information recorded on the information recording medium in accordance with the information based on the usage information (See e.g. [0064], 'When the user selects a desired title for rental from the viewed home page and downloads information thereof to the card 150, data is written in the same format as designation of the next rental described above. Therefore, when the user inserts the card 150 to any of the high speed recording apparatuses 120A to 120M at a rental store, information of the designated next rental is displayed on the apparatus' and Fig. 7).

2. A method of reproducing information using an information recording medium in a client/server system, the method comprising the steps of:

(a) a client obtaining characteristic information of the information recording medium

(See Fig. 7 Step S701, ‘read card management information’ where, as shown in Fig 1, the depicted ‘kiosk returning terminal’ is a client of a ‘kiosk management server’);

(b) the client transmitting the characteristic information to a first server (See e.g. Fig. 7 Step S702, “transmit card management information and own terminal information to distribution center via kiosk management server” where the “distribution center” is the “first server”);

(c) the first server obtaining usage information of the information recording medium based on the characteristic information (See e.g. Fig. 8A Step S801, “receive card management information” and Step S803, “obtain/calculate and prepare user name, program title, usage period, information of additional fee”)

(d) the first server transmitting first information based on the usage information to a second server (See e.g. [0080], ‘In S806; the data thus prepared is transmitted through kiosk management server 170 to kiosk returning terminal 110’ where ‘kiosk management server’ is the ‘second server’);

(e) the second server transmitting second information stored therein to the client in accordance with the first information based on the usage information (See e.g. [0102], ‘The file ID is generated and stored by management data storing apparatus 408 of electronic content programs distributing and returning center server 101 based on the membership number ID as a part of the user information shown in FIG. 13 and content program ID as a part of the content programs information shown in FIG. 14 when a user rents a designated electronic content

program, and written to the card by the high speed recording apparatus 120 at a rental store.

When charging process and payment system are authenticated, the high speed recording apparatus 120 of the rental store writes the content program designated by the user' where the 'charging process and payment system are authenticated' is the 'second information' and is based on the 'user information' which is the 'first information' which includes the 'usage information', and Figs. 5 and 7); and

(f) the client reproducing the information based on the second information received from the second server (See e.g. [0102], 'When charging process and payment system are authenticated, the high speed recording apparatus 120 of the rental store writes the content program designated by the user... to the card').

3. The method as claimed in claim 2, wherein in said step (b), the client transmits the characteristic information to the first server via the second server (See e.g. Fig. 7 Step S702, 'transmit card management information and own terminal information to distribution center via kiosk management server' where the 'distribution center' is the 'first server').

4. A client/server system reproducing information using an information recording medium, comprising:

a client (See Fig. 1, 'kiosk returning terminal' 110); and

a server (See Fig. 1, 'kiosk management server' 170 and 'electronic content programs distributing and returning center server' 101),

wherein the client includes:

a part configured to obtain characteristic information of the information recording medium (See Fig. 7 Step S701, ‘read card management information’ where, as shown in Fig. 1, the depicted ‘kiosk returning terminal’ is a client of a ‘kiosk management server’);

a part configured to transmit the characteristic information to the server (See e.g. Fig. 7 Step S702, ‘transmit card management information and own terminal information to distribution center via kiosk management server’); and

a part configured to reproduce the information recorded on the information recording medium in accordance with information based on usage information of the information recording medium transmitted from the server (See e.g. [0064], ‘When the user selects a desired title for rental from the viewed home page and downloads information thereof to the card 150, data is written in the same format as designation of the next rental described above. Therefore, when the user inserts the card 150 to any of the high speed recording apparatuses 120A to 120M at a rental store, information of the designated next rental is displayed on the apparatus’ and Fig. 7); and
the server includes:

a part configured to obtain the usage information based on the characteristic information of the information recording medium (See e.g. Fig. 8A Step S801, ‘receive card management information’ and Step S803, ‘obtain/calculate and prepare user name, program title, usage period, information of additional fee’); and

a part configured to transmit the information based on the usage information to the client (See e.g. Fig. 7 Step S703, ‘receive information from distribution center via kiosk management server’).

5. A server providing information to a client using an information recording medium in response to a request of the client, the server comprising:

a first part configured to receive characteristic information of the information recording medium from the client (See e.g. Fig. 8A Step S801, 'receive card management information');

a second part configured to obtain usage information of the information recording medium based on the characteristic information (See e.g. Fig. 8A Step S801, 'receive card management information' and Step S803, 'obtain/calculate and prepare user name, program title, usage period, information of additional fee'); and

third part configured to transmit to the client information as to whether reproduction information from the information recording medium is authorized based on the usage information (See e.g. [0080], 'in S802, whether the card 150 is in a state of renting a content program or not is determined. When it is in the rental state, user name, rental title and the like are obtained from a data base, and usage time period (number of dates) and additional fee are calculated in S803' where 'reproduction information' is 'a state of renting a content program' and where an 'additional fee' is calculated if the rental is past due, or not 'authorized').

6. The server as claimed in claim 5, further comprising:

a fourth part configured to receive from the client the characteristic information of the information recording medium and notification requesting stoppage of usage of the characteristic information (See e.g. [0082], 'When kiosk returning terminal 110 confirms whether content programs erasing process may be executed or not to electronic content programs distributing and returning center server 101 (via kiosk management server) in S720, electronic content programs distributing and returning center server 101 receives return confirmation information in S811.

When return condition is satisfied, the center server instructs erasure of the content program in S812. In response, kiosk returning terminal 110 performs content program erasing process in S721. Content program erasure refers to overwriting of card management information so as to make it impossible to read the content program' where 'characteristic information' is 'card management information', 'stoppage' is 'erasure', and the 'kiosk returning terminal' is the 'client');

a fifth part configured to delete the usage information of the information recording medium based on the characteristic information (See e.g. [0082], 'Content program erasure refers to overwriting of card management information so as to make it impossible to read the content program' where 'characteristic information' is 'card management information' and 'usage information', as shown in [0078], 'Card management information stores a title, a rental due date and the like', is included in the 'card management information').

7. A computer-readable recording medium storing a program for causing a computer to execute a method, the method comprising the steps of:

(a) receiving, based on a request of a client using an information recording medium, characteristic information of the information recording medium from the client (See e.g. Fig. 8A Step S801, 'receive card management information');

(b) obtaining usage information of the information recording medium based on the characteristic information (See e.g. Fig. 8A Step S801, 'receive card management information' and Step S803, 'obtain/calculate and prepare user name, program title, usage period, information of additional fee'); and

(c) transmitting the client information as to whether reproduction information from the information recording medium is authorized based on the usage information (See e.g. [0080], 'in S802, whether the card 150 is in a state of renting a content program or not is determined. When it is in the rental state, user name, rental title and the like are obtained from a data base, and usage time period (number of dates) and additional fee are calculated in S803' where 'reproduction information' is 'a state of renting a content program' and where an 'additional fee' is calculated if the rental is past due, or not 'authorized').

8. The computer-readable recording medium as claimed in claim 7 wherein the method further comprises the steps of:

(d) receiving from the client the characteristic information of the information recording medium and notification requesting stoppage of usage of the characteristic information (See e.g. [0082], 'When kiosk returning terminal 110 confirms whether content programs erasing process may be executed or not to electronic content programs distributing and returning center server 101 (via kiosk management server) in S720, electronic content programs distributing and returning center server 101 receives return confirmation information in S811. When return condition is satisfied, the center server instructs erasure of the content program in S812. In response, kiosk returning terminal 110 performs content program erasing process in S721. Content program erasure refers to overwriting of card management information so as to make it impossible to read the content program' where 'characteristic information' is 'card management information', 'stoppage' is 'erasure', and the 'kiosk returning terminal' is the 'client'); and

(e) deleting the usage information of the information recording medium based on the characteristic information (See e.g. [0082], 'Content program erasure refers to overwriting of

card management information so as to make it impossible to read the content program' where 'characteristic information' is 'card management information' and 'usage information', as shown in [0078], 'Card management information stores a title, a rental due date and the like', is included in the 'card management information').

9. A client requesting a server to provide information thereto, the client using an information recording medium, the client comprising:

a first part configured to obtain characteristic information of the information recording medium (See Fig. 7 Step S701, 'read card management information' where, as shown in Fig. 1, the depicted 'kiosk returning terminal' is a client of a 'kiosk management server');

a second part configured to transmit the characteristic information to the server so that the server obtains usage information of the information recording medium (See e.g. Fig. 7 Step S702, 'transmit card management information and own terminal information to distribution center via kiosk management server');

a third part configured to receive information based on the usage information from the server (See e.g. Fig. 7 Step S703, 'receive information from distribution center via kiosk management server'); and

a fourth part configured to reproduce information recorded on the information recording medium in accordance with information based on the usage information (See e.g. [0064], 'When the user selects a desired title for rental from the viewed home page and downloads information thereof to the card 150, data is written in the same format as designation of the next rental described above. Therefore, when the user inserts the card 150 to any of the high speed

recording apparatuses 120A to 120M at a rental store, information of the designated next rental is displayed on the apparatus' and Fig. 7).

10. A computer-readable recording medium storing a program for causing a computer to execute a method, the method comprising the steps of (See e.g. [0055], "Electronic content programs distributing and returning center server 101 incorporates a program for distributing and returning electronic content programs on a server computer" where "server 101" must contain a "computer-readable medium" which would store the "program for distributing and returning"):

(a) obtaining characteristic information of an information recording medium (See Fig. 7 Step S701, 'read card management information' where, as shown in Fig. 1, the depicted 'kiosk returning terminal' is a client of a 'kiosk management server');

(b) requesting a server to provide information and transmitting the characteristic information to the server so that the server obtains usage information of the information recording medium (See e.g. Fig. 7 Step S702, 'transmit card management information and own terminal information to distribution center via kiosk management server');

(c) receiving information based on the usage information from the server (See e.g. Fig. 7 Step S703, 'receive information from distribution center via kiosk management server'); and

(d) reproducing information recorded on the information recording medium in accordance with the information based on the usage information (See e.g. [0064], 'When the user selects a desired title for rental from the viewed home page and downloads information thereof to the card 150, data is written in the same format as designation of the next rental described above. Therefore, when the user inserts the card 150 to any of the high speed recording

apparatuses 120A to 120M at a rental store, information of the designated next rental is displayed on the apparatus' and Fig. 7).

Response to Arguments

Applicants' arguments with respect to objections and rejections not repeated herein are moot, as the respective objections and rejections have been withdrawn in light of the instant amendments.

As per Applicant's argument that Takano does not teach the step of a "server transmitting information based on the usage information to the client" in claim 1, the Examiner respectfully disagrees. Applicant contends that in Step S703 in Fig. 7 of Takano, "the kiosk returning terminal 110 merely receives information from a distribution center via a kiosk management server". The Examiner contends that in order for information to be received by a client it has to be sent by a server. This step is further clarified by Takano [0080-81], "In S805, a customized list is taken out, from preference ID data prepared based on the use history record of the user, from management data recording apparatus 408. In S806, the data thus prepared is transmitted through kiosk management server 170 to kiosk returning terminal 110. Returning to FIG. 7, kiosk returning terminal 110 that has received in S703 the information transmitted in S806 displays the data on display unit 203 in S704".

As per Applicant's argument that Takano does not teach the steps of "a client transmitting characteristic information to a first server, the first server obtaining usage information based on characteristic information and transmitting first information to a second server" in claim 2, the Examiner respectfully disagrees. Applicant contends that "While the

Office Action states that kiosk returning terminal is a client of kiosk management server, it contradicts by stating that the distribution center is the first server". The Examiner contends that there is no contradiction. Applicant's claim does not require the first server to be directly attached to the client. Information stored on the "Electronic Content Programs Distributing And Returning Center Server 101" is transmitted to "Kiosk Returning Terminal A", thus creating a client/server relationship. Identifying a server as first or second is an arbitrary distinction with no specific requirement from the instant claim. There is also no reason that two servers ("Electronic Content Programs Distributing And Returning Center Server 101" and "Kiosk Management Server 170") cannot have the same client ("Kiosk Returning Terminal 110"), as they do in Takano. The instant claim does not limit the client to one server.

Applicant's argument that "Dependent claim 3 should be allowable along with claim 2" is moot with respect to the current rejections.

As per Applicant's argument that Takano does not teach "a server providing information to a client comprising a third part configured to transmit to the client information on authorization" in claim 5, the Examiner respectfully disagrees. Applicant contends that "In the claimed invention, the client transmits a disk ID to the server for authorization, as shown, for example, in Figs. 7-9". This is more specific than the instant claim and therefore has not been addressed by the claim rejection. Applicant further contends that "In step S802 of Takano, the system only detects a card's state of renting a content program". The Examiner stated in the rejection that an overdue rental (which is based on the usage information) is not "authorized". This is a reasonable interpretation based on the definition of "authorization" as an "access privilege" in *Microsoft Computer Dictionary Fifth Edition*, Microsoft Press, 2002. As per Step

S802 only detecting the card's rental status, the rejection must be taken as a whole, and clearly demonstrates that information is transmitted to the client as to whether reproduction information from the information recording medium is authorized based on the usage information.

Applicant's argument that "dependent claim 6 should be allowable along with claim 5" is moot with respect to the current rejections.

As per Applicant's argument's that "The rejection of claims 7 and 8 should be withdrawn for reasons like those discussed above in connection with claim 5", the Examiner is unsure as to what argument the Applicant is referring, since the claims are not identical. However, the Examiner directs the Applicant to the "response to arguments" for claim 5.

As per Applicant's argument that Takano does not teach "a computer-readable medium storing a program for causing a computer to execute a method" as in claim 10, the Examiner respectfully disagrees. Applicant contends that "Takano is directed to a content programs rental method and does not teach all of the limitations of claim 10". However, Takano [0055] states, "Electronic content programs distributing and returning center server 101 incorporates a program for distributing and returning electronic content programs on a server computer" where "server 101" must contain a "computer-readable medium" which would store the "program for distributing and returning".

The Examiner has responded to the Applicant's arguments as completely as possible. Further, the Examiner strongly believes that a *prima facie* case has been clearly established with respect to the prior art rejection of the instant claims given their broadest reasonable interpretation.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron J. Sanders whose telephone number is 571-270-1016. The examiner can normally be reached on M-Th 8:00a-5:00p.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christian Chace can be reached on 571-272-4190. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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4 December 2006